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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,921	07/07/2003	Michael Zunke	2808/12	6947

7590 01/13/2006

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EXAMINER

SHERR, CRISTINA O

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/612,921	<b>Applicant(s)</b> ZUNKE ET AL.	
	<b>Examiner</b> Cristina Owen Sherr	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to the applicant's amendment filed November 1, 2005. Claims 1, 2, 3, 4, 7, 8, 9, 10, 11, 12, 13, 15, 20, and 22 have been amended. Claims 1-22 are pending in this case.

### ***Response to Arguments***

2. Applicant's arguments filed November 1, 2005 have been fully considered but they are not persuasive.

3. Applicant argues that the claims, as amended, are not taught or suggested by the cited art. Specifically, the applicant has amended the claims to reflect determining a licensing policy of a digital product by a plurality of users of an organization. Attention is directed to Ginter et al (US 6,253,193) at, *inter alia*, figure 77, col 255 ln 57 – col 256 ln 7, col 256 ln 19-36:

"VDE distributors 106 may also include "end-users" who provide electronic information to other end-users. For example, FIG. 77 shows a further example of a virtual distribution environment 100 chain of handling and control provided by the present invention. As compared to FIG. 2, FIG. 77 includes a new "client administrator" participant 700. In addition, FIG. 77 shows several different content users 112(1), 112(2), . . . , 112(n) that may all be subject to the "jurisdiction" of the client administrator 700. Client administrator 700 may be, for example, a further rights distributor within a corporation or other organization that distributes rights to employees or other organization participant units (such as divisions, departments, networks, and or groups, etc.) subject to organization-specific "rules and control information." The client administrator 700 may fashion rules and control information for distribution, subject to "rules and control" specified by creator 102 and/or distributor 106".

4. Above, it is obvious that such client-distributors make modifications to the license, and may be one individual or a group of individuals.

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5. Additionally, Stefik et al (US 6,236,971) discloses modification of a license by a user or users, see, e.g. col 16 ln 59 – col 17 ln 10:

“In the present invention, fees may be associated with the exercise of a right. The requirement for payment of fees is described with each version of a usage right in the usage rights language. The recording and reporting of such fees is performed by the credit server. One of the capabilities enabled by associating fees with rights is the possibility of supporting a wide range of charging models. The simplest model, used by conventional software, is that there is a single fee at the time of purchase, after which the purchaser obtains unlimited rights to use the work as often and for as long as he or she wants. Alternative models, include metered use and variable fees. A single work can have different fees for different uses. For example, viewing a photograph on a display could have different fees than making a hardcopy or including it in a newly created work.”

6. As above, it is obvious that such client-distributors make modifications to the license, and may be one individual or a group of individuals.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al (US 6,253,193) in view of Salas et al (US 6,314,408), further in view of Stefik et al (US 6,236,971).

9. Regarding claim 1 –

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Ginter discloses a method for determining a licensing policy of using at least one digital product by at least one user, comprising the steps of: conducting a tolerant licensing policy for the use of the at least one digital product by the at least one user during a trial period; monitoring at least one parameter of said use during said trial period (e.g. col 3 ln 20-50).

10. Ginter does not disclose, but Salas, does, determining a licensing policy according to said monitoring of said at least one parameter to obtain a determined licensing policy (e.g. col 1 ln 32-60).

11. Additionally, both Stefik at col 16 ln 59- col 17 ln 10 and Ginter at col 255 ln 57 – col 256 ln 7 disclose modification of a license by a user or users.

12. It would be obvious for one of ordinary skill in the art to combine the teachings of Ginter, Stefik and Salas as they are in the same art and in order to obtain greater flexibility in the granting of licenses.

13. Regarding claims 2-6 –

Ginter discloses the method of claim 1, wherein said step of monitoring includes collecting at least one sample of said at least one parameter, and wherein said step of determining includes evaluating the performance of said tolerant licensing policy according based on said at least one sample; further comprising steps of, in at least one loop, re-evaluating said determined licensing policy, and optimizing said determined policy according to said re-evaluation; wherein said tolerant licensing policy comprises at least one rule being less restrictive than a corresponding rule of said determined licensing policy; wherein said tolerant licensing policy includes free usage of the at least

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one digital product during said trial period; wherein said at least one parameter is selected from a group consisting of a time count and a run count (e.g. col 48 ln 12-45).

14. Regarding claims 7-8 –

Ginter discloses the method of claim 6, wherein said time count is selected from the group consisting of the time of posting of a request for a license, the time a license is in use by a user, and the average time a user has to wait in a licensing queue until a license is issued; wherein said run count is selected from the group consisting of the number of times licenses have been issued, the number of times a license has been requested, and the number of times a user gave up requesting a license (e.g. col 53 ln 20-50).

15. Regarding claims 9-13 –

Ginter discloses the method of claim 1, wherein said at least one user is selected from the group consisting of at least one machine, at least one organization and at least one department of an organization; wherein said at least one user is defined manually; wherein said at least one user is defined automatically; wherein said at least one user is selected from the group consisting of the first N users that invoked said product during a first predefined period, the first N users that used said product for at least a predetermined duration during a predefined period, and a combination thereof; further comprising ranking said at least one user, and issuing a license to the user having the highest rank among the users waiting in a licensing queue (e.g. col 64 ln 40-55).

16. Regarding claim 14 –

Ginter discloses a method according to claim 13, wherein the rank of a user waiting in a licensing queue is upgraded according to the waiting time of said user in said queue (e.g. col 64 ln 50-55).

17. Regarding claim 15 –

Ginter discloses a method for determining a number of available licenses in a licensing pool, the licenses directed for the use of at least one digital product by at least one user, the method comprising the steps of complying with said maximum number of licenses from said pool that come from said at least one user, and monitoring a count of the issued licenses; and when said trial period is over, determining the maximum available licenses in said pool by implementing at least one optimization method based on said monitoring (e.g. col 3 ln 20-50).

18. Ginter does not disclose, but Salas does, issuing a tolerant maximum number of licenses to said licensing pool (e.g. col 1 ln 32-60).

19. As above, both Stefik at col 16 ln 59- col 17 ln 10 and Ginter at col 255 ln 57 – col 256 ln 7 disclose modification of a license by a user or users.

20. It would be obvious for one of ordinary skill in the art to combine the teachings of Ginter, Stefik and Salas as they are in the same art and in order to obtain greater flexibility in the granting of licenses.

21. Regarding claims 16-20 –

Ginter discloses the method of claim 15, wherein said count is selected from the group consisting of a time count and a run count; further comprising the steps of repeating steps (b) and (c) in at least one loop; wherein said optimization method includes

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counting a percentage of the licenses being used in a time unit; wherein said at least one optimization method includes counting the number of maximum licenses being used at the same time; further comprising ranking said at least one user, and issuing a license to a user having the highest rank among users waiting in a licensing queue (e.g. col 68 ln 30-45).

22. Regarding claims 21-22 –

Ginter discloses the method of claim 20, wherein said rank of a user waiting in a licensing queue is upgraded according to the waiting time of said user in said queue; wherein said rank of a user is determined according to his hierarchy among said at least one users (e.g. col 70 ln 20-35).

23. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

25. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

COS

*[Signature]*  
PRIMARY EXAMINER